



UNITED STATES PATENT AND TRADEMARK OFFICE

R2002-157
COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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AUG 12 2002

In re

:
: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 CFR 10.7(c)
:

MEMORANDUM AND ORDER

(petitioner) petitions for regrading his answers to question 47 of the morning section and question 32 of the afternoon section of the Registration Examination held on October 17, 2001. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 69. On January 11, 2002, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

OPINION

Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct

answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms “USPTO” or “Office” are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

No credit has been awarded for morning question 47 and afternoon question 32. Petitioner's arguments for these questions are addressed individually below.

Morning question 47 reads as follows:

47. Registered practitioner Rick drafted a patent application for inventor Sam. The application was filed in the USPTO on May 15, 2000, with a power of attorney appointing Rick. On March 15, 2001, Sam filed a revocation of the power of attorney to Rick, and a new power of attorney appointing registered practitioner Dave. In a non-final Office action dated September 12, 2001, the examiner included a requirement for information, requiring Dave to submit a copy of any non-patent literature, published application, or patent that was used to draft the application. Which of the following, if timely submitted by Dave in reply to the requirement for information, will be accepted as a complete reply to the requirement for information?

- (A) A statement by Dave that the information required to be submitted is unknown and is not readily available to Dave.
- (B) A statement by Dave that the requirement for information is improper because it was included in a non-final Office action.
- (C) A statement by Dave that the requirement for information is improper because Dave is not an individual identified under 37 CFR 1.56(c).
- (D) A statement by Dave that the requirement for information is improper because information used to draft a patent application may not be required unless the examiner identifies the existence of a relevant database known by Sam that could be searched for a particular aspect of the invention.
- (E) None of the above.

The model answer is selection (A).

37 CFR 1.105(a)(3). 37 CFR 1.105, effective date November 7, 2000, "Changes To Implement the Patent Business Goals; Final Rule," September 8, 2000, 65 FR 54604, 54634; MPEP § 704.12(b) (pg. 700-10) (8th Ed.). (B) is incorrect because the requirement for information may be included in an Office action, or sent separately. 37 CFR 1.105(b). (C) is incorrect because 37 CFR 1.56(c) includes each attorney or agent who prepares or prosecutes the application. 37 CFR 1.56(c)(2). (D) is incorrect because information used to draft a patent application may be required and there is no support for (D) in 37 CFR 1.105. (E) is incorrect because (A) is correct.

The petitioner argues that answer (E) is the best answer because answer (A) is incorrect. The petitioner asserts that by selection answer (A) the reader is "put to the dilemma of underwriting behavior of practitioner Dave which is in conflict with both the spirit and letter of 37 CFR 1.56." The petitioner then explains in detail why answer (A) may be inconsistent with the 37 CFR 1.56 and 10.18(b). Towards the end of his explanation, the petitioner states that if the reader was asked "on its face" which of the answers would be "accepted by the Office," answer A could be arguably the most correct answer.

Petitioner's arguments have been fully considered, but are not persuasive. Although petitioner correctly states that the attorney Dave must make a good faith effort to obtain the requested information, question 47 does not address that issue. The question asks "Which of the following, if timely submitted by Dave in reply to the requirement for information, **will be accepted as a complete reply** to the requirement for information?" (emphasis added). The question is only asking what will be accepted by the Office as a complete reply. Clearly, answer (A) will be accepted as a complete reply by the Office. This policy is set forth in 37 CFR 1.105(a)(3). 37 CFR 1.105, effective date November 7, 2000, "Changes To Implement the Patent Business Goals; Final Rule," September 8, 2000, 65 FR 54604, 54634; MPEP § 704.12(b) (pg. 700-10) (8th Ed.). The Office does not require a showing of efforts made to obtain the information. The statement that the information required to be submitted is unknown and not readily available is generally accepted "on its face."

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 32 reads as follows:

32. Which of the following is true?

(A) Once the issue fee has become due, provided an original application has not been pending more than three years, the applicant may request and the Office may grant a request for deferral of payment of the issue fee.

(B) The time period set for the payment of the issue fee is statutory and cannot be extended. However, if payment is not timely made and the delay in making the payment is shown to be unavoidable, upon payment of a fee for delayed payment, it may be accepted as though no abandonment had occurred, but there will be a reduction on the patent term adjustment for the period of abandonment.

(C) Upon written request, a person citing patents and printed publications to the Office that the person believes has a bearing on the patentability of a particular patent, may request that his or her name remain confidential.

(D) To obtain benefit of priority based on an earlier filed patent application, an applicant in a later filed continuation application is not required to claim priority under 35 U.S.C. § 120 to an earlier filed application.

(E) Each of statements (B) and (C) is true.

The model answer is selection (E).

As to (B), see 35 U.S.C. §§ 151; 154(b)(2)(ii) and (iii); 37 CFR 1.704(c)(3); MPEP § 1306. As to (C) see MPEP §§ 2203 and 2212. As to (D), the claim for priority is not

required, as a person may not wish to do so in order to increase the term of his or her patent. As to (A) deferral under 37 CFR 1.103 is not available following the notice of allowance. Since (B) and (C) are correct, (E) is the best answer.

The petitioner present two separate arguments against the model answer. First, the petitioner argues that answer (B) is not a correct answer, and therefore, answer (E) is not the best answer. The Petitioner argues that answer (B) does not meet all the requirement of 37 CFR 1.137 to revive an abandoned application. Specifically, the petitioner states that the required petition and petition fee are missing from answer (B). Second, petitioner argues that answer (C) could be interpreted in a way to make the answer incorrect. Petitioner states that answer (C) could be viewed in such a way that it is implied the request will be granted and that the name shall be kept confidential. The Petitioner states to this extent the answer is misleading. The Petitioner requests that afternoon question 32 be discarded as being defective.

Petitioner's arguments have been fully considered, but are not persuasive. The facts presented in the answer (B) show that the petition is made by the statement "the delay in making the payment is **shown to be unavoidable**" (emphasis added). The only method consistent with USPTO practice and procedure to make a showing is to file a written statement of facts to support the assertion that the delay was unavoidable. In addition, the petition fee was supplied by the statement "upon payment of a fee for delayed payment." Therefore, since all the necessary requirements of 37 CFR 1.137(a) were met in answer (B), the answer is correct. In regards to the arguments against answer (C), the answer clearly states that "a person ... **may** request ..." (emphasis added). The answer does not imply that the request "shall" be granted. As correctly noted by Petitioner, MPEP 2203 states that the USPTO will attempt to comply with the request, but cannot make any guarantees as to whether the name will indeed remain confidential. Since answer (C) clearly complies with current USPTO policies and procedures, answer (C) is a correct answer. Therefore, answer (E) is the most correct answer because it includes correct answers (B) and (C).

No error in grading has been shown. Petitioner's request for credit on this question is denied.

ORDER

For the reasons given above, no points have been added to petitioner's score on the Examination. Therefore, petitioner's score is 69. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read 'Robert J. Spar', is positioned above the printed name and title.

Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy